

Amendment and Response

Serial No.: 09/479,648

Confirmation No.: 3344

Filed: 7 January 2000

For: METHOD OF APPLYING ADHESIVE COATED FILM

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Remarks

The Office Action mailed 2 April 2003 has been received and reviewed. Claim 37 having been canceled, the pending claims are claims 29-31, 34-36, 38-40, and 57-61. Reconsideration and withdrawal of the rejections in view of the cancellation of claim 37 and the following comments are respectfully requested.

The 35 U.S.C. §112, Second Paragraph, Rejection

The Examiner rejected claims 37 and 57 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner alleges that it is not clear how claim 37 differs from claim 57 as amended.

Applicants submit that the cancellation of claim 37 overcomes the Examiner's rejection. Reconsideration and withdrawal of the rejection is respectfully requested.

The 35 U.S.C. §102/103 Rejection

The Examiner rejected claims 29-31, 34-37, 40, 57-59 and 61 under 35 U.S.C. §102(a/b/e) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over the admitted state of the prior art or Peacock et al. (U.S. Patent No. 5,800,919). Applicants respectfully traverse this rejection. Additionally, Applicants submit that the cancellation of claim 37 renders the rejection as to this claim moot.

To anticipate a claim under 35 U.S.C. §102(a), (b), or (c), the reference must teach each and every element of the claim (M.P.E.P. §2131). Applicants respectfully assert that both the admitted state of the prior art and Peacock et al. fail to teach a Heat Neutral Pressure Source, as recited in independent claims 30, 34, and 57, and the claims dependent thereto.

Peacock et al. is directed to pressure-sensitive adhesives that incorporate small amounts of a plasticizer (Peacock et al., Abstract). The adhesive allows a graphic marking film to be applied at low temperatures (20°F (-7°C)), and resists tenting around compound curved

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surfaces of rivet heads and corrugations typical of truck trailer sides (Peacock et al., Abstract). Peacock et al. disclose a test procedure wherein film is applied to a test panel including rivet heads, the film is heated, and deformed around the rivet head using a rivet brush (Peacock et al., column 10, lines 42-47). There is, however, no teaching in Peacock et al. that the composition of the film-contacting portion of the rivet brush does not appreciably conduct heat either to or from the surface of the film as the film is applied under pressure to a surface on a substrate, preferably having a Thermal Conductivity of less than 1.8 BTU/hr-in-ft²·°F, which is one of the characteristics of a Heat Neutral Pressure Source of the present invention (specification, page 5, lines 22-28).

The Examiner indicated in the present Office Action at page 3, lines 12-16 that substantial air gaps in a typical brush would teach or render obvious the conductivity recited in claim 57, and the burden to prove otherwise is shifted to the Applicants. Applicants respectfully disagree.

First, Applicants point out that thermal conductivity of the rivet brush is not taught in Peacock et al. Second, Applicants assert that the thermal conductivity of a Heat Neutral Pressure Source of claim 57 is not inherent in the rivet brush of Peacock et al. To rely on a theory of inherency, the Examiner "must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (M.P.E.P. §2112). There is no teaching in Peacock that the composition of the film-contacting portion of the rivet brush has the thermal conductivity as recited in claim 57, nor has the Examiner provided any fact or technical reasoning supporting the assertion that the composition of the film-contacting portion of the rivet brush inherently has the thermal conductivity recited in claim 57. Finally, there is no teaching or suggestion, either in Peacock et al. or in the art generally, to modify the teachings of Peacock et al. to provide Applicants' Heat Neutral Pressure Source.

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The Examiner also indicated in the present Office Action at page 3, lines 1-11 that claims 30-31, 34, 35, 40, 58, and 61 are anticipated or rendered obvious as it is implicit in Peacock et al. and the prior art that the tool used would not stick to the softened film. Applicants respectfully point out that a tool that does not stick to a softened film is not explicitly recited any of claims 30-31, 34, 35, 40, 58, and 61, and, furthermore, that the characteristic of not sticking to a softened film is not the exclusive characteristic of the Heat Neutral Pressure Source of claims 30-31, 34, 35, 40, 58, and 61.

Applicants additionally assert that Peacock et al. fail to teach a kit, as recited in Applicants' claim 30.

Applicants respectfully submit that neither the admitted prior art nor Peacock et al. teach every element of Applicants' claims. Reconsideration and withdrawal of the rejection are respectfully requested.

The 35 U.S.C. §102(b) Rejection

The Examiner rejected claim 30 under 35 U.S.C. §102(b) as being anticipated by Alfter et al. (U.S. Patent No. 3,962,016) or Boyd et al. (U.S. Patent No. 4,511,425) or Werstlein (U.S. Patent No. 3,853,669). Applicants respectfully traverse this rejection.

Applicants respectfully submit that neither Alfter et al., Boyd et al., nor Werstlein et al. teach a kit including a Heat Neutral Pressure Source as recited in claim 30.

Alfter et al. teach a process for joining abutting thermoplastic synthetic resin foam sheets or panels including heating a metal strip, pressing the metal strip onto the junction zone, where a heat transfer to the foam material is effected, thereby firmly attaching the metal strip to the junction zone (Alfter et al., column 1, lines 30-42). The film-contacting portion of a Heat Neutral Pressure Source of the present invention does not appreciably conduct heat either to or from the surface of the film (specification, page 5, lines 23-24).

Boyd et al. teach an apparatus for heat transfer labeling of articles wherein decorative laminates affixed to a web are heated by means of a heated platen, a resilient pad (60)

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is pressed against the laminate, whereby the laminate adheres to the pad, and the pad is then pressed against the article to be labeled, to which the laminate adheres in preference to the pad (Boyd et al., Abstract). Applicants respectfully submit that the pad (60) is not a Heat Neutral Pressure Source of the present invention. The resilient pad is heated to an elevated temperature to maintain the label material in a softened, tackified condition (Boyd et al., column 7, lines 34-36). As indicated by the Examiner in the Office Action at page 6, lines 10-11, such configuration is clearly capable of applying heat to a film. However, the Heat Neutral Pressure Source of the present invention does not appreciably conduct heat either to or from the surface of the film. Thus, Boyd et al. fail to teach a Heat Neutral Pressure Source of the present invention.

Werstlein et al. teach a welding tip for a plastic welding gun including a pressure roller for applying softened plastic into the weld seam. Applicants submit that the welding tip of Werstlein fails to teach the Heat Neutral Pressure Source of the present invention that does not appreciably conduct heat either to or from the surface of the film, since "[f]orming an important part of the invention, the present tool [of Werstlein] is made entirely from heat absorbing material" (Werstlein, column 2, lines 54-55; emphasis added). Applicants assert that Werstlein does not disclose a Heat Neutral Pressure Source of the present invention.

In view of the above comments, reconsideration and withdrawal of the rejection are respectfully requested.

The 35 U.S.C. §103 Rejection

The Examiner rejected claims 37, 38 and 57-61 under 35 U.S.C. §103(a) as being unpatentable over the admitted state of the prior art or Peacock et al. (U.S. Patent No. 5,800,919) as applied above, and further in view of Preisler (U.S. Patent No. 3,861,988) and/or Coe (U.S. Patent No. 754,403) and/or Sadtler (U.S. Patent No. 1,672,093). Applicants respectfully traverse this rejection. Applicants respectfully submit that cancellation of claim 37 renders the rejection as to this claim moot. Furthermore, Applicants assert that the comments below additionally apply to independent claim 34 and claims 35, 36, and 40 dependent thereto.

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To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation in the references themselves or the knowledge generally available to one skilled in the art to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the references must teach or suggest all the claim limitations (M.P.E.P §2143).

As indicated above, Applicants assert that neither the prior art nor Peacock et al. teach Applicants claims including a Heat Neutral Pressure Source. Furthermore, neither Preisler, Coe, nor Sadtler provide that which is missing from either Peacock et al. or the prior art.

Preisler teaches a pressure sensitive rolled sheeting applicator and dispenser for applying pressure sensitive sheet material such as paper, plastic, and metal foil that automatically removes the back cover strip and smooths down pressure sensitive adhesive sheeting on a flat surface, and in such a way that paper will adhere to small wall depressions (Preisler, column 1, lines 4-44). There is no teaching or suggestion that heat is applied to the pressure sensitive sheet material. Applicants assert, therefore, there is no motivation to combine the teachings of Preisler with Peacock et al. or the prior art generally wherein the film is heated to soften the film (Peacock et al., column 10, lines 43-44). Nor is there any suggestion that such combination would provide a reasonable expectation of success. Furthermore, Preisler fails to teach or suggest a Heat Neutral Pressure Source of Applicants invention, thus failing to add that which is missing from both Peacock et al. and the prior art.

Coe teaches a Gilder's tool whereby metallic leaf is deposited on uneven surfaces by means of a sponge-rubber pressure pad (Coe, lines 8-25). Coe fails to teach or suggest an adhesive coated film. Furthermore, as in Preisler, there is no teaching or suggestion in Coe of applying heat to the leaf to be applied. In fact, as heat would be detrimental to fragile decorative metallic leaf, Applicants respectfully submit that Coe teaches away from application of heat. It is improper to combine references where the references teach away from their combination (M.P.E.P. §2145). Applicants therefore assert that, as in Preisler, there is no motivation to combine the teachings of Coe with Peacock et al. or the prior art generally wherein

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the film is heated to soften the film, such combination provides no reasonable expectation of success, and Coe fails to teach or suggest the Heat Neutral Pressure Source, which is missing from both Peacock et al. and the prior art.

Sadtler teaches a method by which a surface is decorated using very thin bond paper or onion skin paper having applied thereto the decoration (Sadtler, page 2, lines 38-45). The paper is wetted by applying wet paste or fluid glue between the paper and the surface to which it is to be adhered and pressing the paper with a pad so as to force the paper into continuous contact with the surface to be decorated (Sadtler, page 2, line 62 to page 3, line 45). Sadtler also fails to teach or suggest an adhesive coated film and fails to teach or suggest the application of heat. Therefore, by the same reasoning as Preisler and Coe, there is no motivation to combine the teachings of Sadtler with those of Peacock et al. or the prior art, there is no reasonable success expected with such combination, and Sadtler fails to teach or suggest that which is missing from Peacock et al. and the prior art.

Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

The Examiner rejected claim 39 under 35 U.S.C. §103(a) as being unpatentable over the admitted state of the prior art or Peacock et al. (U.S. Patent No. 5,800,919) as applied above, and further in view of Moore (U.S. Patent No. 1,895,045) and/or Fink (U.S. Patent No. 4,261,783). Applicants respectfully traverse this rejection.

Moore is directed to the application of paint or other marking compound on floors, streets, and highways wherein the painted surface is covered with paper to protect the wet paint from damage until it is dried (Moore, page 1, lines 29-40; page 2, lines 18-19; and page 3, lines 63-70). Applicants respectfully submit that there is no motivation to combine Moore with Peacock et al. or the prior art, as Moore is drawn to nonanalogous art. Furthermore, as there is no teaching or suggestion of a Heat Neutral Pressure Source of Applicants' invention, Moore fails to provide that which is missing from Peacock et al., and the prior art.

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Finke teaches a label printing and applying apparatus including means for printing successive pressure sensitive, relatively stiff adhesive labels, delaminated the labels from a supporting web, and applying the printed delaminated labels to merchandise (Finke, Abstract and column 3, line 13). Finke fails to teach or suggest a method of applying an adhesive-coated film, fails to teach or suggest heating the film to the softening point, and fails to teach or suggest Applicants' Heat Neutral Pressure Source. It is asserted, therefore, that there is no motivation to combine Finke with either the prior art or Peacock et al. in which softening of the film around a rivet head is taught (Peacock et al., column 10, lines 43-44), nor that such a combination would provide a reasonable expectation of success. Furthermore, as Finke fails to teach or suggest Applicants' Heat Neutral Pressure Source, Finke also fails to add that which is missing from Peacock et al. and the prior art.

Reconsideration and withdrawal of the rejections are respectfully requested.

Summary

It is respectfully submitted that the pending claims 29-31, 34-36, 38-40, and 57-61 are in condition for allowance and notification to that effect is respectfully requested.

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The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on this 2nd day of July, 2003, at 10-56 a.m. (Central Time).

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